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10/534,209	04/18/2006	Thierry Charbonneaux	1022702-000265	5179
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary**Application No.**

10/534,209

Applicant(s)

CHARBONNEAUX ET AL.

Examiner

N. EDWARDS

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-25 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 21-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-1, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Applicant urges that 1) the restriction should be withdrawn because a) group I-III are closely related and proper search b) duplicate search inconsistent results c) nominal burden outweighed by public interest, d) no serious burden MPEP 803, and e) in the interest of the economy.

The above arguments are interesting but not deemed persuasive since Applicant has failed to address the Lack of Unity of record on the merits as presented under PCT rule 13 and 37 CFR 1.475. Applicant has failed to state how Groups I-III relate to one another and what is the proper search that would be duplicated and render inconsistent results. An undue burden is shown in the Lack of Unity by the divergent subject matter in group I yarns or fibers or filaments, group II composite, and group III method of making yarn or fiber or filaments. Hence, the Lack of Unity is deemed proper for reasons of record and hereby made **Final**. Claims 18 and 21-25 is withdrawn from consideration since they are directed to a non-elected inventions.

1. Claims 13-17, 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 lines 1 "yarns, fibers or filaments" is vague and indefinite as to the meaning of the phrase. See claims 14-20 for the same problem.

Claim 14, lines 2 "the composition" is indefinite since it lacks proper antecedent basis.

Claim 20 overall is vague and infinite as to the intended meaning of the claim.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 USC 112, for failing to provide an adequate written description of the invention.

The specification as filed fails to set forth¹) What defines or constitutes organic compound of claim 20.

Claim 20 is rejected under 35 USC 112, first paragraph, for the same reason given above in the objection.

3. Claims 13-17 , and 19 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 10/500699 which has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if published or patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application. Specifically, Applicant filed genus and species claims in 10/534209 and 10500699. Thus, since the genus claims includes the species claims obviousness is met.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S.

filing date of the copending application under 37 CFR 1.131. This rejection might also be overcome by showing that the copending application is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Claims 13-17, and 19 are directed to an invention not patentably distinct from claims 36-38 of commonly assigned 10/500,699. Specifically, Applicant filed genus and species claims in 10/534209 and 10500699. Thus, since the genus claims includes the species claims obviousness is met.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1—17 and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 36-38 of copending Application No. 10/500699. Although the conflicting claims are not identical, they are not patentably distinct from each other because Applicant filed genus and species claims in 10/534209 and 10500699. Thus, since the genus claims includes the species claims obviousness is met..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

In the rejections that follow the following assumption(s) has been made yarns, fibers or filaments mean the same thing.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 13,14,15,16,17,19, and 20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yeh (US 5,714,255) alone or optionally taken with Kane (WO 9967451).

Yeh teaches yarns which are made from fibers or filaments teach a thermoplastic polymeric fiber such as polyamide(which includes any and all polyamides such as nylon 6,6 which is same as polyamide 6,6) having about 2% to about 10 % zinc sulfide copper (which is zinc sulfide coated and/or encapsulated in mineral). See col.1lines 38-55 , col.2, col.3lines 6-10, claims 1,2,4,and 5, for example.

Regarding the issue of antibacterial and antifungal properties, the Primary Examiner has a reason to believe that Yeh fibers or yarn inherently possess the claimed properties due to the same structural identity (same fiber composition) as claimed.

Kane is cited to show that it is well known, in the art of polyamide fibers containing zinc sulfide ,that the term polyamide includes any and all nylons such as nylon 6,6. See page6 lines 5-10 of Kane, for example.

8. Claims 13,14,15,16,17, and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kane (WO 9967451).

Kane teaches a plurality of polymeric fibers made from as polyamides which includes any and all nylons such as nylon 6,6 (which is the same thing as polyamide 6,6,) and 0.02% to 5% zinc sulfide (ZnS) in the polymeric fibers. See col.4 lines 227-28, abstract, and page 6 lines 6-10, for example.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kane (WO 9967451) taken with Jacobs'585 (US 5,180,585).

Kane, **a Du Pont Patent**, is applied for the same reason given above which is hereby incorporated by reference. Kane teaches all of the claimed invention except ZnS coated or encapsulated in at least mineral. Jacobs'585, **a Du Pont Patent**, teaches it is well known in the art to coat and/or encapsulated ZnS in at least one metal (mineral) such as copper in order to further improve the antimicrobial properties which is also effective against fungi (which is also antifungal).

Thus, it would have been obvious to one having ordinary skill to combine the ZnS coated and/ or encapsulated with at least one metal (mineral), as taught by Jacobs in the fibers as taught by Kane, in order to further improve the antimicrobial properties of the fiber.

11. Claims 13,14,15,16,and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Roderiguez (US 6,0671612).

Roderiguez teaches yarn or fibers or filaments comprising a thermoplastic polymer and 0.1% to 3% or more of zinc sulfide. See col.2 lines 28-end and abstract for example.

No Claims are allowed.

Art Unit: 1794

The cited patents disclose the state of the prior art.

Any inquiry concerning this communication should be directed to Primary Examiner Edwards at telephone number (571)272-1521.

/N Edwards/
Primary Examiner
Art Unit 1794